

## REMARKS

Claims 1-15 and 17-20 were pending and subject to a restriction requirement.

Claims 14 and 15 are withdrawn.

Claim 21 is new.

Claim 16 is cancelled.

Claims 5, 12 and 15 are amended.

Claims 1-13 and 17-20 are rejected.

Claims 1-15 and 17-21 are pending.

### **Restriction/Election**

On 6/17/04 applicants elected Group I, claims 1-13 and 17-20 with traverse stating all the limitations in claim 15 were also present in claim 1. The Examiner states that the process of claim 1 can be performed by simultaneous addition, which is not required in claim 15. Claim 15 has been amended to include "subsequently or simultaneously adding to the suspending medium". Claim 15 now becomes a linking claim with all the limitations of claim 1. The Examiner should not object to including this as it will not require an additional search. If claim 1 is allowed, then applicants will request a rejoining of claim 15. As claim 15 links claim 14 to claim 1 applicants will also request that claim 14 be rejoined. No new matter has been added.

### **Specification**

The Examiner objects to the specification and would like to see section headings. The Applicants have amended the specification as suggested by the Examiner on pages 3 and 4 of the Office Action of October 6, 2004.

### **35 USC 112, first paragraph**

Claims 1-13 and 17-20 are rejected under 35 USC 112, first paragraph because the specification does not provide enablement commensurate with the scope of claim 1. The Examiner is suggesting that applicants include the limitations in claim 8, 9, 11 and 12 in claim 1.

Applicants respectfully disagree with the Examiner's assessment for the reasons which follow.

The present invention provides a process of flocculating cell material using a specific first polymeric material with a specific second polymer material. The Applicants have discovered that the defined **first and second polymeric materials** are able to flocculate cell material by producing robust flocs suitable for separation under high shear without the need for excessive polymer doses. See page 3, last paragraph. Furthermore the overall polymer dose of the **two polymer system** can be reduced up to 30%. See page 4, paragraph 2. The use of these two different polymers described by their intrinsic viscosity and charge characterization is not disclosed in the prior art.

This particular combination of **two polymers is the broadest scope of the invention**. Applicant is entitled to this broad disclosure. As stated in *As stated in re Fisher*, 166 USPQ 18, 24 (C.C.P.A. 1970)

It is apparent that such an inventor should be allowed to dominate the future patentable inventions of others where those inventions were based in some way on his teachings, are still within his contribution, since the improvement was made possible by his work....

Fisher goes on to state that

It is equally apparent, however, that he must not be permitted to achieve this dominance by claims which are insufficiently supported and hence not in compliance with the first paragraph of 35 U.S.C. 112. That paragraph requires that the scope of the claims must bear a reasonable correlation to the scope of enablement provided by the specification to persons of ordinary skill in the art.

And as further clarified in *National Recovery Techs., Inc. v. Magnetic Separation Sys., Inc.*, 49 USPQ 2d 1671, 1675-76 (Fed. Cir. 1999)

... The scope of enablement, in turn, is that which is disclosed in the specification plus the scope of what would be known to one of ordinary skill in the art without undue experimentation. See *In re Fisher*, 427 F.2d 833, 839, 166 USPQ 18, 24 (C.C.P.A. 1970) ("The scope of the claims must bear a reasonable correlation to the scope of enablement provided by the specification to persons of ordinary skill in the art.")

According to the above case law, the scope of enablement is that which is disclosed in the specification plus the scope of what would be known to one of ordinary skill in the art without undue experimentation.

A person skilled in the art would not consider ratio or amounts of the first polymer and second polymer undue experimentation. As expressed in *re Geerdes*, 180 USPQ 789, 793 (C.C.P.A. 1974)

The question thus raised is whether the scope of enablement, provided one of ordinary skill in the art by the disclosure, is commensurate with the scope of protection sought by the claims. . . . The board expressed concern that "experimentation" is involved in the selection of proportions and particle sizes, but this is not determinative of the question of scope of enablement. It is only undue experimentation which is fatal. . . . One skilled in the extruding art would expect variations in proportions and particle sizes to affect the properties of the foamed product. Also, the specification contains a variety of examples showing different proportions and particle sizes.

Thus the Applicants believe the ratio and amounts of first polymer to second polymer to be values which one skilled in the art could determine and not required as a limitation to claim 1. This is especially true in light of the disclosure whereby a method is also detailed for deciding on the most appropriate dosing. Therefore, the Applicants aver that the claims are commensurate with the scope of the enablement and ask that the 112, first paragraph rejection be withdrawn.

### **35 USC 112, second paragraph**

Claims 1-13 and 17-20 are rejected under 35 USC 112, second paragraph, as being indefinite.

In line 2 of claim 12, the abbreviation DADMAC is replaced by the chemical name. Support for this amendment is found on page 8, beginning of last paragraph.

In line 3 of claim 5 the phrase " and is preferably a copolymer of acrylamide and dimethylaminoethyl acrylate quaternised with methyl chloride" is deleted and new claim 21 specifies the preferred copolymer. No new matter has been added.

As far as the meaning and scope of "substantially non-ionic", this is quite well defined on page 9, last paragraph reading "alternatively the second polymeric material may be substantially non-ionic and may have ionic monomer content below 3 wt. %."

It is respectfully submitted that all the claims submitted for reconsideration are in good formal order. Reconsideration and withdrawal of the rejection of claims 1-13 and 17-20 under 35 U.S.C. §112, second paragraph is therefore solicited.

Reconsideration and withdrawal of the rejection of claims 1-13 and 17-20 is respectfully solicited in light of the remarks and amendments *supra*.

Since there are no other grounds of objection or rejection, passage of this application to issue with claims 1-13 and 17-21 is earnestly solicited.

Applicants submit that the present application is in condition for allowance. In the event that minor amendments will further prosecution, Applicants request that the examiner contact the undersigned representative.

Respectfully submitted,



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